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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.                       | CONFIRMATION NO.            |
|---|-------------|----------------------|---|-----------------------------|
| 10/584,288  | 06/23/2006  | Kouichi Sada         | 17214/013001                              | 8000                        |
| 22511 7590 06/05/2009<br>OSHA LIANG L.L.P.<br>TWO HOUSTON CENTER<br>909 FANNIN, SUITE 3500<br>HOUSTON, TX 77010 |             |                      |   |                             |
|   |             |                      | EXAMINER<br>MC GUTHRY BANKS, TIMA MICHELE |                             |
|   |             |                      | ART UNIT<br>1793                          | PAPER NUMBER                |
|   |             |                      | NOTIFICATION DATE<br>06/05/2009           | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@oshaliang.com  
buta@oshaliang.com

### Office Action Summary

**Application No.**

10/584,288

**Applicant(s)**

SADA, KOUICHI

**Examiner**

TIMA M. MCGUTHRY-BANKS

**Art Unit**

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

Claims 1-10 are currently amended.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/11/2009 has been entered.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 3/19/2009 was filed after the mailing date of the final rejection on 1/14/2009. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 6 and 9 recite the limitation that the product contains neither organic nor oxide binder. However, the specification does not provide for this limitation, e.g. paragraph [0007] in the specification as cited by applicant in the response filed 5/11/2009.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3 and 6-8 is rejected under 35 U.S.C. 102(b) as being anticipated by Minnick (US 3,645,719).

Minnick is applied as discussed in the office action mailed 1/14/2009. The product does not have to contain oxide but can contain carbonate (column 5, lines 7-10).

Claims 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 07102302.

JP '302 as applied as discussed in the office action mailed 8/11/2008. The limitation of the solid product containing neither organic nor oxide binder is intended use. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Additionally,

the manner of operating the device does not differentiate apparatus claims from the prior art. See MPEP § 2114.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minnick as applied to claims 1 and 3 above, and further in view of Anderson (US 2002/0020108 A1)

Minnick discloses the invention substantially as claimed. However, Minnick does not teach the size of the product as in claim 4 or the ratio of the height to the diameter as in Claim 5. Anderson teaches a combustible briquette as described in the office action mailed 8/11/2008. The size depends on a number of factors with a preferred size of 2 in x 2 in (50.8 mm x 50.8 mm) [0020]. The size of the briquette could be greater, which reads on the claimed range of 0.7-0.8. It would have been obvious to one of ordinary skill in the art at the time the invention was made to expect that the product in Minnick could have the size taught in Anderson, since applying the known technique of making a briquette of a certain size is a design choice. Anderson and Minnick both teach making briquettes with metallurgical dusts.

***Response to Arguments***

Applicant's arguments filed 5/11/2009 have been fully considered but they are not persuasive. Applicant argues that Minnick does not teach pressing and reforming dusts. However, Claim 1 is a product by process claim, and even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself.

The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or as obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP § 2113. Claim 6 does not claim the steps of pressing and reforming. The argument with respect to JP '302 is addressed above in the rejection. The remainder of the prior art argued by applicant has been withdrawn due to the amendments to the claims.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIMA M. MCGUTHRY-BANKS whose telephone number is (571)272-2744. The examiner can normally be reached on M-F 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/584,288  
Art Unit: 1793

Page 6

/Roy King/  
Supervisory Patent Examiner, Art Unit  
1793

/T. M. M./  
Examiner, Art Unit 1793  
3 June 2009